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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,511	12/27/1999	RUDOLF RITTER	PM 265420	2426
909	7590	03/03/2005	EXAMINER	
PILLSBURY WINTHROP, LLP			REAGAN, JAMES A	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			3621	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/446,511

Applicant(s)

RITTER ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the response filed on 09 February 2005.
2. Claim 1 has been amended.
3. Claims 1-21 and 23-26 have been examined.

RESPONSE TO ARGUMENTS

4. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. In addition, the Examiner is hereby rescinding the finality of the previous Office based on the Applicant's observation that the Ramachandran reference does not qualify as prior art. The current rejection below will address the amended limitations as cited in the amendment filed on 13 September 2004. Consequently, this action is made final.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai (Unexamined Japanese Patent No. 8-249530) in view of Vazvan (WO 96/13814) and O'Mahony et al, "Electronic Payment Systems", further in view of Martineau (US 5,915,226 A).

Claims 1, 2, 7, 16-18, 21 and 23:

Arai, Figure 5, teaches an automatic vending system utilizing a mobile telephone such that Applicants' step of transmitting customer identification, via a contactless Interface reads on the call originating source identification information or individual identification information, Applicants' step of checking, by the terminal, customer identification reads on the controller (located at the terminal) determining whether the mobile telephone number (customer identification information) is registered, paragraph (0024), Applicants' step of transmitting a transaction amount reads on the value of the selected commodity, Applicants' step of charging reads on the billing information stored at the terminal in the storage part, element 22, paragraph (0044), and Applicants' step of preparing, in said terminal, a transaction document and transmitting the transaction document to a telephone firm (service center), reads on paragraphs [0013) and (0014). Although Arai does not teach using a removable identification module, Vazvan discloses a wireless telephone debit card removable from a radio telephone and that the card can be increased via wireless communication. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Arai to include a removable identification module/card as taught by Vazvan as the module/card may then be used with other module/card reading systems besides the telephone.

Although the combination of Arai/Vazvan does not teach electronically signing the document, O'Mahony et al, pages 113 -116, teach the particulars of a merchant capturing payment from a payment server wherein cryptographic protocols are used to securely transmit transaction information when communicating via the internet. More particularly, Applicants' step of electronic signing, reads on the merchant signing a capture request (can be transmitted in batch form - claim 7) wherein the request contains transaction data, figure 4.39 (Capture Token - claim 22), Applicants' step of checking the signature reads on the payment server verifying the

request and Applicants' step of paying reads on the payment to the merchant account the amount of the purchase, bottom of page 115 to first paragraph of page 116 (claim 2). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize cryptographic techniques for communicating transaction information over a public network, as is taught by O'Mahony et al, as utilizing those techniques are a well-known secure method of communicating transaction information.

With regard to the limitations of:

- *said mobile radio telephone is employed in a mobile radio network and comprises a mobile device and said identification module wherein said identification module is removable and stores at least the customer identification and a monetary amount; and*
- *said monetary amount is able to be reloaded through secured reloading documents from a service centers wherein said reloading documents are transmitted by means of digital messages via said mobile radio network;*

Martineau, in at least column 2, lines 1-5 discloses a combination SIM/Smart card, and in column 3, lines 44-55 discloses value units associated with the card, as well as using the SIM card in a Traditional subscription service (see at least column 3, lines 23-44), teaching that the stored value on the card may be replenished as necessary. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Martineau with Arai/Vazvan/O'Mahony because the smart card/cell phone system provides a convenient and user-friendly communication service.

With regard to the newly added limitation of *without an intermediate transceiver*, The Examiner takes **Official Notice** that using an RF or IR signal to communicate without a repeater or transducing device i.e. line of sight, is old and well-known in the electronic communication arts. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the cell phone as shown to be a value-bearing device with wireless capabilities. Modifying the cell phone to

include an alternative and equivalent wireless technique would be obvious to one of ordinary skill in the wireless communication arts.

Claim 3:

O'Mahony et al, pages 102 -103, illustrate the use of a merchant, customer, acquirer (clearing unit) and bank for card transactions. Purchasing methods have long been known to use acquirers (clearing units, archives, payment gateways, third parties, certification authorities etc.) and servers (banks, financial institutions etc.) as a means for conducting transactions between a merchant and a customer. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art to use a clearing unit as well as a server as taught by O'Mahony in the system taught by Arai/Vazvan as a clearing unit would free up server usage and is usually less expensive as a result.

Claims 4 - 6:

O'Mahony et al, page 109, teach the use of SET protocol wherein according to an aspect of the SET protocol, the customer (identification module) sends a digital signature to the merchant who passes it on to the acquirer/service center as a means of informing the acquirer that the cardholder consents to the particular transaction.

Claims 8 -10, 24 and 25:

While none of the references disclose black lists, a black list is considered a fundamental and recognized technique for banks and retailers to keep track of cards (whether they are smart cards, debit cards, wallets or credit cards) that are lost, stolen, or misused and to prevent those cards from being used in transactions. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize checking "black lists" as money could be lost to everyone legitimately concerned in the transaction.

Claim 11:

Vazvan teaches that the transaction card is a SIM card.

Claims 12 - 15:

Although Vazvan does not specifically teach that the SIM is a transponder or communicates via an integrated inductance or infrared, these are fundamental and recognized techniques for communication. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined teachings of Arai and Vazvan to include any communication technique desired as the device will have more utility in having more choices for communication.

Claim 19:

O'Mahony teach various electronic payment systems wherein it is disclosed that some item information (voucher) transmitted between entities do not need to be encoded while for other items of information (within the same data transmission) are proper to be encoded. See page 81, Section 4.6.4 'CyberCash messages' of O'Mahony et al. Therefore, it is considered that it would have been obvious at the time of the invention to save processing time of the receiver of the items of information if only the information requiring privacy from eavesdroppers were to be encoded and not, for instance, the order information or client/transaction ID.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai/Vazvan/O'Mahony/Martineau, and further in view of Yacobi.

Claim 20:

Although none of the references, Arai/Vazvan/O'Mahony/Martineau specifically teach the encryption method claimed, Yacobi, in at least column 9, lines 47 -51, teaches the combined usage

of symmetrical and asymmetrical encryption for transmission of monetary information wherein the session key (symmetrical) is encrypted with the recipient's public key (asymmetrical). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to use this type of encryption as it is believed to be one of many methods for the secure transmission of information.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai/Vazvan/O'Mahony/Martineau, and further in view of Pitroda '038.

Claim 26:

While Arai/Vazvan/O'Mahony/Martineau do not disclose a memory on the SIM card for recording transactions, but rather a printer for printing out such information, Pitroda teaches an identity/UET card wherein this information is kept, element 410. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the card of Vazvan to include a transaction record memory so that this information does not have to be printed out on each and every occasion but could be kept in the card for instances, for example, when paper is not available for printing that information. Further, Pitroda teaches that communication between the service center and the UET card is possible, column 16, lines 52 - 54.

Arai's system also has the ability for communication between the mobile phone and service center.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including

After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

01 March 2005

